REMARKS

Claims 1 to 28 and 31 to 33 are pending, of which Claims 1, 11, 16 and 24 are independent. Claim 1 is amended. Reconsideration and further examination are respectfully requested.

By way of an introduction and a non-limiting example, one or more embodiments have application in an advertising industry that serves ads via a network to a user computer, and desires to monitor the effectiveness of served ads. Any of a number of measures might be used in monitoring an ad's effectiveness, including capturing the number of times the ad is viewed by a user (often referred to as a "page view"), the number of times a user activates a link in the ad to the advertiser's web page (often referred to as a "click-through"), the number of times a user makes a purchase after activating a link in the ad (often referred to as an "acquisition").

In accordance with a conventional approach described in the present application, an "ad-serving entity" receives advertising content from advertisers or agencies, and uses a staff of programmers to incorporate received ad content into ad code before the ad content is served to a user computer. This process must be repeated any time the ad content and/or ad code changes. Such work is labor intensive and results in both decreased profits for the entities serving the ads and, to the extent the cost is not completely absorbed by the entity serving the ad, increased advertising costs to the advertiser and/or agency.

In accordance with aspects of the invention presently claimed, an integrated ad file, which is served to a computer to provide the ad, is created by combining an ad input file, which identifies ad content, with a conduit file, which comprises computer code to provide the ad and to identify ad tracking code. Among the advantages of this arrangement, an advertiser may provide the content to any number of different ad-serving entities without concerning itself with the ad tracking methodologies that are to be used with the content. Similarly, a tracking methodology can be selected and implemented independent of the ad content. On one hand, advertisers may modify the ad content without implicating changes to the tracking code, and on the other hand, modifications can be made to the tracking methodology and code without implicating changes to the ad content.

Claims 1, 4, 7 to 10 and 33 are rejected under 35 U.S.C. § 102(b) over a white paper by Solbright entitled "The Inside Edge on Rich Media Partnership Series"(referred to herein as

Solbright), Claims 2, 3, 5, 6, 11 to 28, 31 and 32 are rejected under 35 U.S.C. § 103(a) over Solbright and the Official Notice taken by the Examiner. Reconsideration and withdrawal of the rejection are respectfully requested for at least the reasons set forth below.

The Applicant's previous response requested the Examiner to provide the necessary support for the Official Notice taken by the Examiner. While the Examiner maintained the rejection and continues to rely on Official Notice in the current Office Action, the Examiner did not provide the necessary support requested by the Applicant. The Applicant renews its request that the Examiner provide the requisite support for the Official Notice, should the Examiner continue to rely on Officially Noticed facts. For at least the reasons provided below, however, the Applicant submits that the grounds for rejection should be withdrawn.

Claim 1 recites a method for providing an ad via a computer network. According to the method, an ad input file is combined with a conduit file to create an integrated ad file. The ad input file identifies the contents of the ad and the conduit file contains computer code for providing the ad and for identifying tracking data for the ad. The integrated ad file contains both the ad input file and the conduit file contents is served from a computer to provide the ad.

Solbright fails to teach, suggest or disclose a conduit file, combining a conduit file with an ad input file, creating an integrated ad file by combining an ad input file with a conduit file, and/or serving an integrated ad file created by combining the ad input file and the conduit file.

The Office Action cites pages 17 to 19 of Solbright and states that:

> "Solbright teach integrating an input file (Flash ad) and conduit file
> (tracking code) and creating an integrated ad file from a computer
> to provide an ad."

As is described in the cited portion, Solbright requires that someone, such as a programmer, modify a Flash ad file to include action code in the ad file. See, for example, the process described at page 18 of Solbright, which requires that someone manually add a "getURL(clickTag) action" to a Flash ad file. The Examiner concedes that Solbright requires that a Flash ad be manually edited. More particularly, in the stated grounds for rejecting Claims 2, 3, 13, 14, 22, 23 and 28 found at page 3, the Examiner states that Solbright describes "designers creating their ads and developers or programmers adding the tracking string after the ads are created." It is clear that Solbright suffers from the same conventional shortcomings

described in the background of the present application and discussed above. In order to track an ad, for each Flash ad file, Solbright's approach requires that a programmer edit the file to include the getURL action code to the Flash ad file. If a change needs to be made to the action code, or a new Flash ad file is created, additional programming effort is needed to edit Solbright's Flash ad file. In stark contrast, the invention of the present claims creates an integrated ad file by combining an ad input file and a conduit file, the integrated ad file comprises the ad input file contents that identify the content of the ad and the conduit file contents that comprise computer code to provide the ad and to identify tracking data. A modified integrated ad file can be created by combining a modified ad input file and/or a modified conduit file.

Solbright does not disclose or even suggest a conduit file, let alone the claimed conduit file, which comprises computer code to provide the ad and to identify tracking data, and which is combined with an ad input file to create an integrated ad file that is served to provide the ad. Solbright's Flash ad is manually modified to include the getURL code that retrieves a URL from the HTML, and nothing in Solbright even mentions a conduit file. While the Examiner contends that "tracking code" corresponds to the claimed conduit file, as is clear from the concessions made by the Examiner in the Office Action discussed above, tracking code *per se* cannot and does not disclose or even suggest a conduit file, let alone a conduit file which is combined with an ad input file to create an integrated ad file as is recited in Claim 1. Furthermore, there is nothing in the grounds for rejection or the Examiner's response to the Applicant's previous remarks that identifies what element of Solbright the Examiner considers to correspond to the claimed integrated ad file. Solbright's Flash ad that is manually edited cannot be said to be the same as an integrated ad file that is created by combining a conduit file with an ad input file. Nothing in Solbright teaches, suggests or discloses combining an ad input file and a conduit file to create an integrated ad file. Solbright's HTML wrapper consists of a URL that is retrieved *after* both the ad file and the HTML wrapper have been served the user computer - the ad is displayed in a browser window of the user's computer, and the user provides button input in connection with the displayed ad. An HTML wrapper that is only accessed after a Flash ad is served and displayed to a user computer, and after the user interacts with the displayed ad, cannot be said to correspond to the claimed conduit file or the claimed integrated ad file, the latter of which is created by combining the claimed conduit file with the claimed ad file and

served from a computer to provide an ad, and further cannot be said to correspond to the ad input file and conduit file combined to create the integrated ad file.

The Examiner's comments found at page 8 of the current Office Action state the following:

> According to applicant's invention the advertiser creates the
> content of the ad (504) and the portal uses [merge tool] 502 to [add
> a] conduit file (tracking code) to the ad. Therefore, the tracking
> code [is] created and added to the ad file at the server, same as the
> prior art; the same as creating an HTML wrapper file that uses the
> <OBJECT> and <EMBED> tags to pass the appropriate
> parameters for the tracking string to the ad and then each publisher
> will need to modify this file (wrapper file) to insert their own,
> unique tracking code (same as applicant merge [tool] to add the
> tracking code (conduit file)).

The Examiner's position, it is respectfully submitted, assumes facts that are not supported by Solbright. Solbright's HTML wrapper file is never combined with an ad input file to create an integrated ad file. As is recited in the claims of the present application, a conduit file is combined with the ad input file to create an integrated ad file. As is described in connection with at least one embodiment described in the present application, a merge tool 502 is used to combine an ad input file with a conduit file to create an integrated ad file at the server, which integrated ad file is then served to provide the ad. Solbright's HTML wrapper file and ad file are discrete files that must be served separately. Furthermore, Solbright's parameter passing, which passes a value from the HTML file to Solbright's ad file, occurs at the client computer after the HTML file and the ad file have been served, after the ad is displayed in a browser window of the user's computer, and the user interacts with a button displayed in the browser window to provide button input in connection with the displayed ad. Solbright never combines its HTML file and its ad file, and in fact never combines its ad file with any other file to create an integrated ad file. Solbright does not teach, suggest or disclose a conduit file that comprises computer code to provide the ad and to identify tracking data for the ad. Solbright cannot therefore create an

integrated ad file by combining a conduit file with an ad file, and further cannot serve an integrated ad file that is created by combining an ad input file with a conduit file.

For at least the foregoing reasons, Claim 1 is believed to be patentable over Solbright. In addition, Claims 2 to 10 and 31 to 33, which depend from Claim 1, are also believed to be patentable over Solbright for at least the same reasons.

Furthermore and with respect to Claim 2, a modified integrated ad file is created by combining a received modified ad input file representing a change to the content of an ad with the conduit file. Claim 3 recites steps of receiving a modified conduit file representing a change to the tracking data, combining the modified conduit file with the ad input file to create a modified integrated ad file, and serving the modified integrated ad file, to provide an ad having the changed tracking data.

The Office Action concedes that Solbright fails to teach or to suggest a modified ad file or conduit file, and further fails to teach or suggest receiving a modified ad file or conduit file. The Office Action alleges that:

> "it would have been obvious to one or ordinary skill in the art at
> the time of the invention to known [sic] that the designer or
> programmers of Solbright would accept a new or modified
> information or content from the source and insert the same or
> different tracking information according to the goals of the
> campaign or the preference of the tracking server."

According to the description provided by Solbright and in view of the concessions made in the Office Action, however, any modifications made in Solbright must be made by a programmer editing the Flash ad. There is nothing in Solbright that corresponds to the claimed conduit file, and/or combining the claimed conduit file and an ad input file to create an integrated ad file. It follows then that nothing in Solbright corresponds to creating a modified integrated ad file by combining a modified ad input file with a conduit file (Claim 2) or by combining an ad input file with a modified conduit file (Claim 3). To the extent that the Examiner is relying on "Officially Noticed" facts, the Applicant hereby traverses such Official Notice based at least on the above discussion and the concessions made in the Office Action, and specifically requests the Examiner to provide documentary evidence of any such "Officially Noticed" facts, should the

Examiner maintain the rejection. For similar reasons, the Applicant traverses the rejection of Claims 13, 14, 22, 23 and 28, and requests that the Examiner provide documentary evidence of each Officially Noticed fact, should the Examiner maintain her rejection of these claims.

Referring to Claim 5, the ad input file includes an empty movie clip object such that the combining of an ad input file with a conduit file to create an integrated ad file recited in Claim 1 includes inserting the conduit file into the empty movie clip object. Claim 6 depends from Claim 5, and further recites that the empty movie clip object is given a predefined name and combining the ad input and conduit file includes searching the ad input file for the predefined name and inserting the conduit file into the empty movie clip with the predefined name.

In rejecting Claims 5 and 6, the Office Action concedes that Solbright fails to teach or to suggest an ad input file that includes an empty movie clip object, fails to teach or to suggest inserting a conduit file in the empty movie clip object, fails to teach or to suggest an empty movie clip object having a predefined name, and further fails to teach or to suggest searching the ad input file for the predefined name of the empty movie clip object. The Office Action then assumes "Officially Noticed" facts, and alleges that such facts somehow suggest each and every one of the elements of Claims 5 and 6 not disclosed or taught by Solbright. In view of the complete absence of any teaching or suggestion in Solbright with respect to multiple elements of Claims 5 and 6, as conceded in the Office Action, the Applicant traverses the Official Notice taken in the Office Action. Should the Examiner maintain the rejection, the Applicant respectfully requests that the Examiner provide evidentiary support for the "Officially Noticed" facts, and requests that the Examiner provide documentary evidence with respect to the claimed empty movie clip object of the ad input file into which the claimed conduit file is inserted, combining an ad input file and a conduit file by inserting the conduit file into the empty movie clip of the ad input file, searching the ad input file for a predefined name of the empty movie clip of the ad input file, and combining an ad input file to create an integrated ad file by inserting the conduit file into the empty movie clip having the predefined name in the ad input file.

With respect to Claims 7 to 10, the Office Action alleges that pages 18 to 20 of Solbright teach an ad input file specifying one or more button actions, each of which has an exit code (Claim 7); a conduit file (Claim 8), or JavaScript file (Claim 9), which includes code that determines whether an ad opens in a parent window or a new window using a variable included

in HTML code used to serve the integrated ad file; and tracking an ad using code in the claimed
conduit file and a tracking identifier included in HTML code serving the claimed integrated ad
file (Claim 10). A review of the portion of Solbright generally referenced in the Office Action
fails to uncover any portion of Solbright that discloses or suggests at least the above-identified
elements of Claims 7 to 10. Should the Examiner maintain the § 102(b) rejection of Claims 7 to
10 over Solbright, the Examiner is respectfully requested to identify the particular portions and
elements of Solbright that the Examiner considers teaches each and every one of the elements
recited in Claims 7 to 10.

      With regard to Claims 11, 12, 15 to 21, 16 and 24 to 27, the Office Action contends
(commencing at page 4) that:

> "Solbright teaches identifying a first file (flash ad); identifying a
> second file (tracking information); wherein the first file specifies
> ad content code and the second file contains ad-tracking code;
> creating an ad file including computer code for providing the ad;
> wherein the first file specifies ad content code and the second file
> contains an ad-tracking code; html code loading ad file (third file);
> third file including one or more buttons; creating the [sic] (see pp
> 17-20). Solbright does not explicitly teach identifying a
> placeholder (an empty movie clip) in the first file and
> electronically inserting the second file in the placeholder to create
> an ad file. However official notice is taken that [it] is old and well
> known in the art of programming to create an empty movie clip
> using Macromedia Flash. Macromedia Flash is used to create an
> empty movie clip, one that contains no data or graphic content, so
> that external files (JPGS or SWF) can be loaded into it. Therefore,
> it would have been obvious to one of ordinary skill in the art at the
> time of the invention to create an empty movie clip, in rich media,
> as a placeholder for external files such as the tracking data to be
> inserted into it, if the ad is a movie clip."

With regard to the Official Notice taken in the Office Action, the Applicant respectfully refers the Examiner to MPEP § 2144.03, which states that Official Notice is only appropriate in a limited number of circumstances and should only be taken where the facts are capable of instant and unquestionable demonstration as being well known or common knowledge. It should not be used simply as a matter of convenience. The Applicant traverses the Official Notice taken in the Office Action. Should the Examiner maintain her rejection of the claims based on Officially Noticed facts, the Applicant respectfully requests that the Examiner provide documentary support for each fact Officially Noticed. The requested documentary support is particularly important in view of the Examiner's own admission in her grounds for rejecting Claims 2, 3, 5, 6, 11 to 28, 31 and 32, in which the Examiner concedes that the only documentary evidence of record relied on to make the § 103(a) rejection of these claims fails to teach, suggest or disclose multiple elements of these claims.

As is discussed above in connection with Claim 1, the Office Action concedes that Solbright's approach uses a programmer to manually add tracking information to a Flash file, which is not the same as the claimed method, which combines a conduit file and an ad input file to create an integrated ad file.

With regard to independent Claims 11, 16 and 24, the Examiner concedes that Solbright fails to teach or suggest a placeholder in a file, identifying a placeholder in a first file and electronically inserting a file in the placeholder to create an ad file, it is clear that Solbright's approach cannot teach, suggest or disclose the methods of Claim 11, 16 or 24. The Applicant traverses the Official Notice taken by the Examiner in rejecting Claims 11, 12, 15 to 21 and 24 to 27, including any "Officially Noticed" facts that the Examiner alleges disclose or suggest inserting one or more file into a respective placeholder identified in another file to create an ad file, as recited in Claims 11, 16 and 24. In addition, the Applicant traverses the Official Notice taken by the Examiner in rejecting Claims 12, 15, 17 to 21 and 25 to 27, including any Officially Noticed facts that the Examiner alleges teach, disclose or suggest the elements of these claims, including inserting a file that contains ad-tracking code into the placeholder identified in another file which specifies ad content code to create an ad file (Claim 12); a placeholder into which a file is inserted to create an ad file comprises an empty movie clip (Claims 15, 17, 27); combining first and second files into first and second placeholders in a third file to create an ad file, the third

file including one or more buttons corresponding to links to one or more web pages, and wherein HTML code specifies URLs for the one or more web pages (Claim 19); using an executable program (Claim 20), or a web-based application (Claim 21) to insert first and second files into first and second placeholders in a third file; inserting a conduit file into a placeholder identified in an ad input file to create an integrated ad file (Claim 25); and inserting a conduit file created using Flash into a placeholder identified in an ad input file created using Flash to create an integrated ad file (Claim 26). Should the Examiner maintain her rejection of Claims 11, 12, 15 to 21, 16 and 24 to 27, she is respectfully requested to provide documentary support for each Officially Noticed fact.

Claim 31, depends from Claim 24, and further recites that the integrated ad file includes one or more exit codes referring to one or more URL variables. Claim 32, which depends from Claim 31, further recites that the integrated ad file is designed to be loaded by code, the code specifying one or more URLs corresponding to the one or more URL variables referred to by the one or more exit codes included in the integrated ad file, the code populating the one or more URL variables with the one or more URLs.

In rejecting Claims 31 and 32, the Office Action generally cites pages 17 to 20 of Solbright. Upon a review of the cited portion of Solbright, nothing was found that can be said to teach, suggest or disclose one or more exit codes referring to one or more URL variables, and/or an integrated ad file that is to be loaded by code that specifies one or more URLs corresponding to one or more URL variables, the code populating the one or more URL variables with the one or more URLs. Should the Examiner maintain the grounds for rejection of these claims, the Applicant respectfully requests that the Examiner provide specific references to the components and portions of Solbright that the Examiner considers correspond to each and every element recited in Claims 31 and 32.

For at least the foregoing reasons and the concessions made in the Office Action, Solbright is missing multiple elements of each of Claims 1 to 28 and 31 to 33. Solbright cannot therefore form the basis for a § 102 rejection, and reconsideration and withdrawal of the § 102(b) rejection of the claims so rejected are respectfully requested. Furthermore, Solbright cannot form the basis for a §103(a) rejection of the claims, as the record is devoid of a teaching of the missing elements.

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In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney. Alternatively, since it is believed that the claims of the present application are in condition for allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the Examiner's earliest convenience.

The Applicant's attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address given below, which is the address associated with Customer Number 76058.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket Number is referenced when charging any payments or credits for this case.

Respectfully submitted,

Date: January 29, 2008

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